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UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF CALIFORNIA

IN RE: AMERANTH PATENT LITIGATION	**Lead Case No. 11cv1810 DMS (WVG)**
	PLAINTIFF AMERANTH, INC.'S BRIEF IN SUPPORT OF DISCOVERY DISPUTE

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INTRODUCTION

Defendant GrubHub Holdings Inc.'s ("GrubHub") attempt to depose Plaintiff Ameranth, Inc.'s ("Ameranth") former patent prosecution counsel and current litigation counsel, Michael Fabiano, is nothing more than a belated, procedurally defective fishing expedition. GrubHub claims – *with no evidence whatsoever* – that Ameranth intentionally failed to disclose three prior art references during the prosecution of the '077 Patent. Despite the fact that GrubHub had *ample* opportunity to ask Ameranth about this purported failure during depositions or through written discovery, it made absolutely no attempt to do so. Now, after the close of fact discovery and the deadline to depose fact-controlled witnesses, and in a desperate attempt to salvage its deficient defense, GrubHub attempts to conduct this discovery *for the first time* by subjecting opposing counsel to a deposition and overly broad document requests. In addition to the fact that the Subpoena is untimely and procedurally defective, as explained below, this Court has made clear that when a party seeks to depose opposing counsel, *the burden shifts* to that party to establish that it could not have obtained the information from some other source, that the information is relevant and non-privileged, and that the information is crucial to the party's case. Because GrubHub cannot satisfy this burden, Ameranth respectfully requests that the Court quash the Subpoena and prohibit GrubHub from seeking discovery from its counsel, Michael Fabiano.

RELEVANT FACTUAL BACKGROUND

On August 28, 2018, counsel for GrubHub emailed Ameranth's counsel a copy of a subpoena issued to Michael Fabiano ("Subpoena"), former patent prosecution counsel for Ameranth with respect to the '077 Patent, and current litigation counsel for Ameranth in connection with this action. (Declaration of Brandon J. Witkow ("Witkow Decl."), ¶ 2 and Exh. A). In the email, GrubHub's

counsel asked whether Ameranth's counsel would accept serve of the subpoena. (*Id.*) No other parties were copied on the email. (*Id.*) On August 30, 2018, GrubHub then personally served the Subpoena on Mr. Fabiano at his home. (*Id.*, ¶ 3). To Ameranth's knowledge, GrubHub has never served the Subpoena on any other parties. (*Id.*) The Subpoena demanded the deposition of Mr. Fabiano on September 11, 2018, and the production of seven categories of documents by September 10, 2018. (Witkow Decl., Exh. A). These categories include "all documents and communications" regarding three prior art references: U.S. Patent No. 7,069,228 to Rose; U.S. Patent No. 6,356,543 to Hall; and U.S. Patent No. 6,415,138 to Sirola. (*Id.*) They also include "all documents and communications" regarding a Final Office Action for a different patent application filed by Ameranth (U.S. Appl. Ser. No. 11/190,633), as well as "all documents and communications" regarding the patent examiner for that different patent application (*i.e.*, USPTO Examiner Rutao Wu). (*Id.*)

On August 31, 2018, Ameranth's counsel sent counsel for GrubHub a meet and confer letter regarding the Subpoena, explaining why the Subpoena was untimely, procedurally defective, and improper. (Witkow Decl., Exh. B). The parties met and conferred telephonically on September 6 and 12, 2018. (*Id.*, ¶ 4). During those discussions, GrubHub's counsel argued that GrubHub believed the deposition and documents were necessary to support its defense of inequitable conduct. (*Id.*) Ameranth's counsel requested that GrubHub identify when or where this discovery had been sought from Ameranth or any other source; counsel for GrubHub admitted that he had made no attempt to determine whether GrubHub or any other defendant in this litigation had ever requested this information from Ameranth or any other source. (*Id.*) The parties then jointly contacted Judge Gallo's Clerk on September 12, 2018, who instructed the parties to file these Briefs. (*Id.*)

THE SUBPOENA IS UNTIMELY AND PROCEDURALLY DEFECTIVE

The deadline for GrubHub to conduct discovery was August 31, 2018. [Dkt. No. 1257]. While the Court recently entered an order extending *expert and third-party discovery* to September 17, 2018 [Dkt. No. 1281], that order does *not* apply to the deposition of Mr. Fabiano, as it is without question that Mr. Fabiano is neither an expert nor a third party in this matter. The parties made a clear distinction between ***party-controlled witnesses*** and ***third-party witnesses*** in the Joint Case Management Statement and Discovery Plan that they submitted to the Court. [Dkt. No. 334, at IV(i)]. The Court adopted this language in its Order Following Second Case Management Conference and Case Management Order. [Dkt. No. 345, 4.I]. Given Mr. Fabiano's role as prosecution counsel for Ameranth for the '077 Patent, as well as Ameranth's litigation and trial counsel in this matter, he is most certainly an "Ameranth-controlled witness." Thus, if GrubHub intended to depose or seek documents from Mr. Fabiano, it was required to do so on or before August 31; yet, the Subpoena seeks the production of documents by Mr. Fabiano on September 10, 2018, and calls for his deposition on September 11, 2018 – ***well after the August 31, 2018 discovery deadline***.

Furthermore, "[i]f the subpoena commands the production of documents, electronically stored information, or tangible things or the inspection of premises before trial, then before it is served on the person to whom it is directed, a notice and a copy of the subpoena must be served ***on each party***." *See* Fed. R. Civ. P. 45(a)(4) (emphasis added). Here, the Subpoena *did* seek the production of documents, yet it was *not* served on each party before it was served on Mr. Fabiano. (Witkow Decl., at ¶ 2 and Exh. A). Failure to properly serve a Subpoena constitutes grounds to quash. *See, e.g., Schweizer v. Mulvehill*, 93 F.Supp.2d 376, 411–412 (S.D.N.Y. 2000).

A DEPOSITION OF MR. FABIANO IS UNNECESSARY AND IMPROPER

This Subpoena is an inappropriate and unduly burdensome fishing expedition. These document requests are overbroad, with no attempt to exclude obviously privileged documents and communications. Yet, GrubHub has no evidence whatsoever – *because no evidence exists* – to support its false assertion of any intent by Ameranth or Mr. Fabiano to intentionally withhold three prior art references from the examiner during prosecution of the '077 patent. GrubHub, as the party alleging inequitable conduct, bears the burden of proving a threshold level of intent to deceive by clear and convincing evidence. *See Therasense, Inc. v. Becton, Dickinson and Co*., 649 F.3d 1276, 1291 (Fed. Cir. 2011). "The absence of a good faith explanation for withholding a material reference does not, by itself, prove intent to deceive." *Id.* GrubHub has not and cannot identify *any* evidence supporting a "threshold level of intent to deceive."

As GrubHub concedes, the three references were cited and discussed in the file history for the '633 patent application. The entire '633 patent application file history was included as an exhibit in the *Menusoft* trial (Witkow Decl., Exh. C at Exh. 8). As set forth on the face of the '077 Patent, Ameranth identified and disclosed the *Menusoft* trial exhibits, including the '633 application and its file history, to the Examiner for the application that later issued as the '077 Patent, and the Examiner confirmed, in December 2011, that he had reviewed each item in that Information Disclosure Statement. (Witkow Decl., Exh. D at p. 4; Witkow Decl., Exh. E at p. 2). Despite this irrefutable evidence, GrubHub now seeks – *after the cutoff of party discovery* –to subject Ameranth's litigation counsel to a deposition and document requests because GrubHub failed to conduct party discovery that it could have conducted months (or even years) ago, under the false pretense that Ameranth's litigation counsel is a "third party" subject to the extended discovery deadline. This subpoena is just an afterthought

by GrubHub in a weak and desperate attempt to prove a baseless theory, and it cannot be permitted. *See Sterne Kessler Goldstein & Fox, PLLC v. Eastman Kodak Co.*, 276 F.R.D. 376, 384 (D.D.C. 2011) (holding that defendant's claim that deposition of plaintiff's counsel could lead to non-privileged, factual information relevant to defendant's inequitable conduct defense was "exactly the type of fishing expedition that courts have attempted to prevent when seeking to deter deposition of counsel").

In *Shelton v. Am. Motors Corp.*, 805 F.2d 1323 (8th Cir. 1986), the Eighth Circuit developed a test on the appropriateness of deposing opposing counsel that has been expressly adopted by several other courts, including the Southern District of California. *See, e.g., Am. Cas. Co. of Reading, Pa. v. Krieger*, 160 F.R.D. 582, 585, 588 (S.D. Cal. 1995) (applying *Shelton* test), *Textron Fin'l Corp. v. Gallegos*, 2016 WL 4169128, at *2 (S.D. Cal. Aug. 5, 2016) (stating "*Shelton* is generally considered the leading authority, and has been adopted in this district"); *Eclipse Group LLP v. Target Corporation*, 2017 WL 2103573, at *7 (S.D. Cal. May 12, 2017). While a party moving to quash a subpoena normally has the burden of persuasion, under *Shelton*, the burden shifts. The party seeking opposing counsel's deposition must show it needs the deposition by demonstrating the following factors: (1) no other means exist to obtain the information other than to depose opposing counsel; (2) the information sought is relevant and nonprivileged; and (3) the information is crucial to the preparation of the case. Here, GrubHub cannot satisfy its burden of demonstrating these three factors.

First, GrubHub cannot show that no other means exist to obtain the information other than to depose opposing counsel. In the case of the deposition of opposing counsel who is also patent prosecution counsel, courts have regularly invoked this rule to forbid or limit the deposition of prosecution counsel when it

is clear that the information sought by the opposing party is readily available from another source that does not so seriously implicate privilege or work product concerns, such as written discovery or the deposition of the plaintiff or inventor. *See, e.g., Sterne,* 276 F.R.D. at 385 (deposition of prosecution counsel regarding inequitable conduct defense was not permitted because the desired information related to inequitable conduct claim was more readily available from the inventor, who had already been deposed); *ResQNet.com, Inc. v. Lansa, Inc.*, 2004 WL 1627170, at *5 (S.D.N.Y. July 21, 2004) (rejecting the defendant's attempt to depose opposing counsel re inequitable conduct because defendant had "already deposed the inventors of the patents alleged to be relevant, and those depositions included detailed questions about the patent prosecution histories, the cited prior art, the patents in suit, and numerous related issues" and "the prosecution histories speak for themselves"); *Games2U, Inc. v. Game Truck Licensing LLC*, 2013 WL 4046655, at *9 (D. Ariz. Aug. 9. 2013) (deposition of prosecution counsel was not permitted where "[i]t is not apparent that [the prosecuting attorney's] deposition would lead to relevant discovery that is not available from other sources"); *Petka v. Mylan Pharm., Inc.* 2016 WL 6947589, at *4 (N.D. Cal. Nov. 28, 2016) (holding that "the minimal benefit [defendant] is likely to gain [by deposing plaintiff's patent prosecution counsel] ultimately is outweighed by the risk of encountering privilege and work-product issues").

Here, GrubHub had many opportunities to obtain this information from an equally reliable source in a more convenient, less burdensome fashion, and it failed to do so. GrubHub *never* served a Rule 30(b)(6) deposition notice seeking testimony on these topics. Neither GrubHub nor any other defendant *ever* asked any questions on these topics during any depositions of Ameranth's fact or Rule 30(b)(6) witnesses. GrubHub *never* served any interrogatories or document requests on these topics. (Witkow Decl., ¶ 5). During the meet and confer

process, counsel for Ameranth asked GrubHub to identify any effort made by GrubHub or any other defendant to obtain this information from Ameranth itself, and GrubHub counsel was unable to do so. (*Id.*, ¶ 4).

Second, GrubHub cannot show that the information sought is relevant and nonprivileged, as GrubHub has offered no evidence of any intent by Ameranth or Mr. Fabiano to withhold these references, and to the extent any responsive documents exist, they would either be publicly available (*i.e.*, in the prosecution file history) or they are privileged. Further, GrubHub has not submitted any expert reports regarding the issue of inequitable conduct. (*Id.*, ¶ 5).

Third, GrubHub cannot show that the information is crucial to the preparation of the case. Again, there has been no evidence put forth of any intent by Mr. Fabiano or Ameranth, so this is nothing more than a fishing expedition. *See Sterne*, 276 F.R.D. at 384-85 ("Deposing an opposing party's former counsel on the same matter at issue in the pending litigation, should not be done lightly. Simply claiming that an opposing party's former counsel has 'non-privileged, factual information' without specifying precisely what information is sought or the benefit of that information is insufficient to overcome the potential risks that the Federal Rules were intended to protect against"). Moreover, if this evidence was "crucial", GrubHub would have sought to obtain it directly from Ameranth before the discovery cutoff. It did not.

CONCLUSION

For the foregoing reasons, Ameranth respectfully requests the Court quash the Subpoena and prohibit GrubHub from seeking discovery from Mr. Fabiano.

Dated: September 19, 2018 Respectfully submitted,

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By: /s/ William J. Caldarelli
William J. Caldarelli
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CERTIFICATE OF SERVICE

I hereby certify that on September 19, 2018, I electronically transmitted the foregoing document to defendants' counsel of record via the court's CM/ECF electronic filing system.

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